

## **Remarks**

Applicants respectfully request reconsideration of the present application. Claims 1-39 were rejected in the Office Action mailed on December 29, 2005. By virtue of this amendment, claims 1, 18, and 32 have been amended. No new matter has been added to the present application, and no claims have been cancelled. Accordingly, claims 1-39 are pending herein. Claims 1-39, as amended herein, are believed to be in condition for allowance, and such favorable action is respectfully requested.

### **Rejections based on 35 U.S.C. § 103(a)**

Claims 1-10, 13-26, and 28-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2005/0052685 to Herf et al. (“Herf”) in view of U.S. Patent No. 6,029,191 to Kurashima (“Kurashima”). Additionally, claims 11, 12, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Herf in view of Kurashima and U.S. Patent No. 6,674,992 to Helmick et al. (“Helmick”). Applicants respectfully traverse these rejections because a *prima facie* case of obviousness under 35 U.S.C. § 103(a) cannot be made on the claims, as amended herein.

#### A. Applicable Authority

To establish a *prima facie* case of obviousness, three criteria must be met: (1) there must be some suggestion or motivation – either in the references themselves or in the knowledge generally available to one of ordinary skill in the art – to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior-art references must teach or suggest all the claim limitations. *See* MPEP § 2143. Furthermore, the teaching or suggestion, and the reasonable expectation of success must be found in the prior art and not be based on applicants’ disclosure. MPEP § 2143 (referencing *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991)).

“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” MPEP § 706.02(j) (citing *Ex parte Clapp*, 227 USPQ 972, 972, (Bd. Pat App. & Inter. 1985)). The examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Dembicza*k, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

B. Rejection of claims 1-10, 13-26, and 28-39 based on Herf in view of Kurashima

1. *Herf in view of Kurashima does not teach or suggest executing multiple routines in parallel to convert, transfer, and load a set of media objects.*

Referring initially to independent claim 1, as amended herein, applicants respectfully submit that each limitation of claim 1 has not been suggested or taught by either Herf, Kurashima, or any combination thereof. In particular, claim 1, as amended herein, teaches a media viewer and “a presentation engine component in the media viewer for presenting the set of shared media objects using multiple routines executed in parallel that convert, transfer, and load the set of shared media objects . . . .” (emphasis added). Such a component must be taught by Herf and Kurashima to properly reject claim 1 under § 103(a).

Neither Herf, Kurashima, nor any combination thereof teach a component using multiple routines executed in parallel that convert, transfer, and load media objects. Herf discloses a system for transmitting images over a network using a number of sequential steps. See Herf, para. 0070. First, a sending user pushes permission data regarding one or more images to a recipient user’s terminal. See Herf, paras. 0012, 0032, 0046, 0070. From the images submitted by the sending user, the recipient user selects which images to view and transmits a

request for those images in desirous resolutions to the sending user's terminal. *See* Herf, paras. 0027, 0046, 0048, 0070. In response to the request, the sending user terminal transmits the requested images in the desirous resolutions to the recipient user. *See* Herf, paras. 0032, 0048, 0070. Herf does not specifically disclose independent routines that convert, transfer, and load a set of media objects. Moreover, the examiner specifically stated in the office action that "Herf does not teach that multiple routines are executed in parallel." The examiner later concluded in the office action that Kurashima taught such a limitation.

Kurashima is directed to processing application programs either on one terminal or in parallel on multiple terminals. Parallel execution of application programs on multiple terminals, however, is only disclosed in Kurashima under the following two conditions: (1) when a plurality of application programs are individually operated in a "share mode," and (2) when the internal states of all application programs are matched. *See* Kurashima, col. 6, lines 60-67; col. 7, lines 1-7. By way of contrast, claim 1, as amended herein, does not require designating a share mode before or matching internal states before executing multiple routines in parallel. Furthermore, Kurashima does not suggest or teach – either individually or in combination with Herf – executing routines that convert, transfer, and load media objects. Lacking these and other recited features, applicants respectfully submit that a *prima facie* case of obviousness based upon the Herf and Kurashima references, either alone or in combination, cannot be established for claim 1, as amended herein. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of claim 1 is respectfully requested.

The method of claim 18, as amended herein, teaches "selectively presenting a set of shared media objects under control of at least one of the users using the messaging client using multiple routines executed in parallel that convert, transfer, and load the shared media

objects . . ." (emphasis added). As previously mentioned, neither Herf, Kurashima, nor any combination thereof suggest or teach multiple routines executed in parallel that convert, transfer, and load media objects. Lacking these and other recited features, applicants respectfully submit that a *prima facie* case of obviousness based upon the Herf and Kurashima references, either alone or in combination, cannot be established for claim 18, as amended herein. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of claim 18 is respectfully requested.

The method of claim 32, as amended herein, teaches "executing multiple routines in parallel that convert, transfer, and load the set of shared media objects . . ." (emphasis added). As previously mentioned, neither Herf, Kurashima, nor any combination thereof suggest or teach multiple routines executed in parallel that convert, transfer, and load media objects. Lacking these and other recited features, applicants respectfully submit that a *prima facie* case of obviousness based upon the Herf and Kurashima references, either alone or in combination, cannot be established for claim 32, as amended herein. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of claim 32 is respectfully requested.

Each of claims 2-10 and 13-17 depends, either directly or indirectly, from independent claim 1. In addition, each of claims 17-26 and 28-31 depends, either directly or indirectly from independent claim 18. Further, each of claims 33-39 depends, either directly or indirectly from independent claim 32. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.' *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." MPEP § 2143.03. As previously mentioned, a *prima facie* case of obviousness cannot be supported by Herf and Kurashima for independent claims 1, 18, and 32. Therefore, applicants respectfully submit that a *prima facie* case of obviousness based upon Herf and Kurashima cannot be established for claims 2-10, 13-26, and 28-31 for at least the same

reasons as cited above. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of claims 2-10, 13-26, 28-31, and 33-39 is respectfully requested.

2. *No suggestion or motivation exists to combine or modify Herf with Kurashima.*

Even if the combination of Herf and Kurashima did teach every claim limitation, as amended herein, of the present invention, applicants respectfully submit that there is no suggestion or motivation to modify or combine Herf with Kurashima. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *See* MPEP § 2143.01(I). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” MPEP § 2143.01(III) (emphasis added).

The systems and methods disclosed in Herf are directed to enabling users to share images over a network using little or substantially no bandwidth. *See* Herf, p. 1, para. 0011; p. 3, para. 0034. This is accomplished in Herf by a sequential process of sharing images across the network. First, a sending user pushes permission data regarding one or more images to a recipient user’s terminal. *See* Herf, paras. 0012, 0032, 0046, 0070. From the images submitted by the sending user, the recipient user selects which images to view and transmits a request for those images in desirous resolutions to the sending user’s terminal. *See* Herf, paras. 0027, 0046, 0048, 0070. In response to the request, the sending user terminal transmits the requested images in the desirous resolutions to the recipient user. *See* Herf, paras. 0032, 0048, 0070. Instead of transmitting all of the actual images initially offered by the sending user, only the requested

images in the recipient user's desired resolutions are transmitted. Transferring only selected images at selected resolutions specified by the recipient user reduces the quantity of data actually transferred across the network – requiring substantially little or no bandwidth. The parallel processing disclosed in Kurashima would not reduce the bandwidth necessary to transfer the recipient user's requested images across the network, because parallel processing would not effect the quantity and resolution of files desired by the recipient user. Accordingly, applicants respectfully submit that combining Herf with Kurashima would not satisfactorily aid the reduction of bandwidth necessary to transfer images across the network, and thus no suggestion or motivation to combine the Herf reference with the Kurashima reference exists.

C. Rejection of claims 11, 12, and 27 based on *Herf* in view of *Kurashima* and *Helmick*

Claims 11 and 12 depend, either directly or indirectly, from claim 1. Also, claim 27 depends directly from claim 18. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” MPEP § 2143.03. As previously mentioned, neither Herf, Kurashima, nor any combination thereof can support a *prima facie* case of obviousness to the claims, as amended herein, of the present application. Furthermore, Helmick does not teach the aforementioned limitations of claims 1, 18, and 32, as amended herein, requiring the execution of multiple routines executed in parallel that convert, transfer, and load shared media objects. Therefore, applicants respectfully submit that combining Helmick with Herf and Kurashima cannot support a *prima facie* case of obvious to reject claims 11, 12, and 27. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of claims 11, 12, and 27 is respectfully requested.

**Conclusion**

For at least the reasons stated above, claims 1-39 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejection and allowance of claims 1-39. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. It is believed that no fee is due in conjunction with the present amendment. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,



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